

REMARKS/ARGUMENTS

Reconsideration of the subject patent application in view of the present remarks is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 1-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Go (U.S. Patent No. 6,091,938) in view of Ohta (EP 1345389) and further in view of Mizuta (U.S. Patent Application Publication No. 2003/0211874). For at least the following reasons, the Examiner's rejection is respectfully traversed.

With regard to Go, the reference does not make the disclosures asserted by the Office action. First, the Office action appears to argue that the limitation “the first and second cabinets are in a slide move state” is described because the cam hinge 50 and the hinge cover 70 move along the wire 80 upon opening or closing of the flip from or to the main set. However, the cam hinge 50 and the hinge cover 70 are not “cabinets” as a person of ordinary skill in the art would construe these terms to mean. The “Background art” section of the application describes that the cabinets can be contracted (closed state) for easy carrying of the mobile terminal apparatus and expanded (open state) for easy telephone conversation (see p. 1, lns. 19-25). Based on how the term “cabinet” is used in the specification, a person of ordinary skill in the art would not understand a “cabinet” to refer to the cam hinge 50 or the hinge cover 70 of Go.

Moreover, the Office action appears to agree that these features are not “cabinets” since the Examiner believes it necessary to bolster the disclosure of Go with Mizuta after having already argued that Go describes the “cabinets.” With respect to claim 1, Mizuta is cited for the sole purpose of disclosing a slide-type phone. Thus, the redundancy can only be explained by the fact that even the Examiner thinks that the cam hinge 50 and the hinge cover 70 of Go do not

sufficiently describe the “cabinets” that “are in a slide move state.” Furthermore, the reliance on Mizuta is itself problematic because a proper reason to combine it with the other references is not provided. Go and Ohta describe flip-style phones and the Office action does not provide a reason as to why a person of ordinary skill in the art would have a reason to combine the slide-type phone of Mizuta with Go or Ohta. There is no indication why a person of ordinary skill in the art would contemplate the application of a muting feature in Mizuta. The absence of a logical explanation is an indication that the use of Mizuta in this combination is based on improper hindsight reasoning.

Second, Go does not contain an enabling disclosure of the limitation inhibiting “signal transmission...if the first and second cabinets are in a slide move.” The Office action refers to the phrase “the radiophone includes circuitry or software for reducing or eliminating the noises caused by the opening and closing of the flip” (col. 4, lns. 1-3). However, other than this one phrase, Go provides no detail as to the circuitry or software for accomplishing such an objective. Giving weight to such a broad statement when no other detail is provided would be analogous to construing, for example, the statement ‘this apparatus includes mechanisms for traveling from point A to point B’ as rendering unpatentable all specific applications of transportation that are later invented. According to MPEP § 2121.01, in determining that quantum of prior art disclosure which is necessary to declare an applicant’s invention ‘not novel’ or ‘anticipated’ within section 102, the stated test is whether a reference contains an ‘enabling disclosure.’ *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d

1051, 1054, 68 USPQ 1373, 1376 (Fed. Cir. 2003). A reference contains an “enabling disclosure” if the public was in possession of the claimed invention before the date of invention. The weight of this statement should be limited to whatever art, if any, that deals with reducing or eliminating the noises caused by the opening and closing of the flip and such weight could be attributed to the statement only after the Examiner has provided documentary evidence showing the state of the art at the time.

Due to these reasons, the rejection of claim 1 and claims depending therefrom was improper and must be withdrawn.

Claim 2

Claim 2 has been amended to recite language consistent with claim 1.

With regard to claim 2, there is nothing in Ohta that describes the limitation “the voice control unit continues the muting for a predetermined time period from the point in time when the first and second cabinets enter the open state or the closed state from the slide move state.” Ohta describes that the muting means stops its operation when the top lid is fully open or the driving time of the top lid opening/closing means has reached a predetermined time (see col. 9, lns. 1-5). Ohta specifies that the predetermined time is a previously measured time from when the motor 111 starts to be driven to when the top lid reaches the fully open or fully closed state (see col. 6, lns. 5-8). In other words, unlike the claimed subject matter, the time in Ohta is measured from the moment the top lip leaves the fully open or fully closed state and reaches a fully closed or fully open state. Nothing in Ohta indicates that muting extends beyond such a time.

Thus, the rejection was improper and must be withdrawn.

Claim 4

The Office action states that “a switch which...is pressed as the opposed cabinet makes a slide move” is described by Ohta because it teaches “a controller that switches the muting section as the radio terminal opens/closes.” The term “switch” in claim 4 refers to a structural element that can be pressed and the fact that the muting section “switches” or is activated does not show the presence of a “switch” because the muting section could be activated without the use of a “switch.” The Office action refers to a motor driving button 121 in Ohta but this button is operated by a user and is not pressed by a cabinet. Thus, the rejection was improper and must be withdrawn.

Conclusion

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No.: NGB-40213.

Respectfully submitted,
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